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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/829,573   | 04/10/2001  | Ryuichiro Hisamatsu  | 450100-03152        | 7755             |
| 20999  | 7590        | 10/15/2003           | EXAMINER            |                  |
| FROMMERM LAWRENCE & HAUG<br>745 FIFTH AVENUE- 10TH FL.<br>NEW YORK, NY 10151 |             |                      | ELISCA, PIERRE E    |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 3621                |                  |

DATE MAILED: 10/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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|   |                                      |   |  |
|---|--------------------------------------|---|--|
| <b>Office Action Summary</b>  | Application No.<br><b>09/829,573</b> | Applicant(s)<br><b>Ryuichiro, Hisamatsu et al.</b>                          |  |
|   | Examiner<br><b>Pierre E. Elisca</b>  | Art Unit<br><b>3621</b>   |  |
| <i>-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --</i>  |                                      |   |  |
| <b>Period for Reply</b>   |                                      |   |  |
| <p>A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>THREE</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.</p> <ul style="list-style-type: none"> <li>- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.</li> <li>- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.</li> <li>- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.</li> <li>- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).</li> <li>- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).</li> </ul> |                                      |   |  |
| <b>Status</b>   |                                      |   |  |
| 1) <input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>Oct 10/2001</u>   |                                      |   |  |
| 2a) <input type="checkbox"/> This action is FINAL.      2b) <input checked="" type="checkbox"/> This action is non-final.   |                                      |   |  |
| 3) <input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11; 453 O.G. 213.   |                                      |   |  |
| <b>Disposition of Claims</b>  |                                      |   |  |
| 4) <input checked="" type="checkbox"/> Claim(s) <u>1-22</u> is/are pending in the application.  |                                      |   |  |
| 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.   |                                      |   |  |
| 5) <input type="checkbox"/> Claim(s) _____ is/are allowed.  |                                      |   |  |
| 6) <input checked="" type="checkbox"/> Claim(s) <u>1-22</u> is/are rejected.  |                                      |   |  |
| 7) <input type="checkbox"/> Claim(s) _____ is/are objected to.  |                                      |   |  |
| 8) <input type="checkbox"/> Claims _____ are subject to restriction and/or election requirement.  |                                      |   |  |
| <b>Application Papers</b>   |                                      |   |  |
| 9) <input type="checkbox"/> The specification is objected to by the Examiner.   |                                      |   |  |
| 10) <input type="checkbox"/> The drawing(s) filed on _____ is/are a) <input type="checkbox"/> accepted or b) <input type="checkbox"/> objected to by the Examiner.<br>Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).   |                                      |   |  |
| 11) <input type="checkbox"/> The proposed drawing correction filed on _____ is: a) <input type="checkbox"/> approved b) <input type="checkbox"/> disapproved by the Examiner.<br>If approved, corrected drawings are required in reply to this Office action.   |                                      |   |  |
| 12) <input type="checkbox"/> The oath or declaration is objected to by the Examiner.  |                                      |   |  |
| <b>Priority under 35 U.S.C. §§ 119 and 120</b>  |                                      |   |  |
| 13) <input checked="" type="checkbox"/> Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).<br>a) <input checked="" type="checkbox"/> All b) <input type="checkbox"/> Some* c) <input type="checkbox"/> None of:<br>1. <input checked="" type="checkbox"/> Certified copies of the priority documents have been received.<br>2. <input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____.<br>3. <input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).<br>*See the attached detailed Office action for a list of the certified copies not received.  |                                      |   |  |
| 14) <input type="checkbox"/> Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).<br>a) <input type="checkbox"/> The translation of the foreign language provisional application has been received.   |                                      |   |  |
| 15) <input type="checkbox"/> Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.  |                                      |   |  |
| <b>Attachment(s)</b>  |                                      |   |  |
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   |                                      | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  |                                      | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____   |                                      | 6) <input type="checkbox"/> Other: _____                                    |  |

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**Examiner Pierre Eddy Elisca**  
**United States Department of Commerce**  
**Patent and Trademark Office**  
**Washington, D.C. 20231**

**DETAILED ACTION**

1. This Office action is in response to Application No. 09/829,573, filed on 04/10/2001.
  
2. Claims 1-22 are pending.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pargee, Jr. (U.S. Pat. No. 4,422,093) in view of Stern (U.S. Pat. No. 6,591,247).

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**As per claims 1, 3-6, 8, and 10-22, Pargee** substantially discloses a virtual service that employs the full facilities of a satellite television communication channel, comprising the steps of: obtaining information about earnings and expenses based on expenses incurred by content providers (content providers or satellite television broadcasting, cable television) supplying users with recording devices compatible with contents offered by the providers (see., abstract, col 3, lines 15-30, col 6, lines 18-38). Pargee fails to explicitly discloses advertisements and fees included in the contents. However, Stern discloses an advertising and payment method/system to disseminate information concerning multiple products. The advertisements information is associated with various products or contents (see., abstract, col 1, lines 37-67, col 3, lines 12-32, col 4, lines 46-67, it is obvious to recognize that satellite or cable broadcastings provide earnings for service provide to consumers). Therefore, it would have bee obvious to a person of ordinary skill in the art at the time the invention was made to modify the television burst service of Pargee by including the limitations detailed above as taught by Stern because this would advertise consumers in the television industry while ensuring that consumers is ready to perceive the message content of the advertisement.

**As per claims 2, and 9, Pargee** discloses the claimed method wherein said services constitute electronic commerce practiced by virtual shops (see., abstract, specifically wherein it is stated that a virtual service that employs the full facilities of a television communication channel on an intermittent basis, col 3, lines 3, lines 19-67).

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**As per claim 7, Pargee discloses the claim method wherein said recording devices each include a hard disc drive (fig 4, col 7, lines 17-50).**

***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1, 13, and 19 are rejected under 35 U.S.C. 101 because it is directed to non-statutory subject matter, specifically, as directed to an abstract idea.

Claims 1, 13, and 19 represent an abstract idea that does not provide a practical application in the technological arts. There is no computer performing any step, therefore, Applicant is advised to embed a computer or processor or module into claims 1, 13, and 19 in order to overcome this 101 rejection. Appropriate correction is required.

***Conclusion***

7. Any inquiry concerning this communication from the examiner should be directed to Pierre Eddy Elisca at (703) 305-3987. The examiner can normally be reached on Tuesday to Friday from 6:30AM. to 5:00PM.

If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305-9768.

**Any response to this action should be mailed to:**

**Serial Number: 09/829,573**

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Commissioner of Patents and Trademarks

Washington, D.C. 20231

The Official Fax Number For TC-3600 is:

**(703) 305-7687**



Pierre Eddy Elisca

Patent Examiner

**October 07, 2003**